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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,792	06/27/2003	Anne O'Malley	50655.1500	6883
66170 7590 04/14/2010 Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER NGUYEN, HIEP VAN				
ART UNIT 3686		PAPER NUMBER		
NOTIFICATION DATE 04/14/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/608,792

Applicant(s)

O'MALLEY ET AL.

Examiner

HIEP NGUYEN

Art Unit

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Status

1. Claims 1-25 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Jan. 22, 2010 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (US. 6,014,644) in view of Walker et al. (US. 5,945,653).

5. With respect to Claim 1, Erickson teaches a system for membership enrollment comprising:

- a. an enrollment system including an enrollment system server for processing data in connection with a user ('644; Col. 7, lines 6-43);
- b. a first supplier system for providing a first membership indicia to said enrollment system in response to said user data provided for enrollment in a first membership program ('644; Col. 7, lines 44-67, Fig 1; Col. 8, lines 51-66; Fig 2);
- c. a second supplier system for providing a second membership indicia to said enrollment system in response to said user data provided for enrollment in a second membership program, said second membership indicia different from said first membership indicia ('644; Fig 1, Col. 7, lines 44-67; Col. 8, lines 51-66; Fig 2)

Erickson does not disclose clearly:

- d. a readable storage device including a database for storing said first and second membership indicia, and said user data;
- e. an enrollment system reader in communication with said readable storage device and said enrollment system server, said reader receiving said user data .

However, Walker et al. discloses a readable storage device including a database for storing said first and second membership indicia, and said user data; and an enrollment system reader in communication with said readable storage device and said

enrollment system server, said reader receiving said user data ('653; Fig 4; Col. 12, lines 25-55; Col./line 13/49-14/41.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the requests for quotation' system of Giovannoli ('178; Abstract) the use of a readable storage device (credit card) at point of sale (reader) as taught by Walker et al. ('653; Abstract) for providing membership enrollment as described in the invention.

Claim 12 is rejected as the same reason with Claim 1.

6. With respect to Claim 2, the combined art teaches a system according to claim 1. Walker et al. discloses wherein said reader is in communication with said enrollment system for providing said user data to said first and second suppliers ('653; Col. 18, lines 16-22).

Claim 13 is rejected as the same reason with Claim 2.

7. With respect to Claim 3, the combined art teaches system according to claim 1. Walker et al. discloses wherein said enrollment system server provides said first and second membership indicia to said readable storage device, said readable storage

device storing said first and second membership indicia in said readable storage device database ('653; Col./line 15/51-16/67).

Claim 14 is rejected as the same reason with Claim 3.

8. With respect to Claim 4, the combined art teaches a system according to claim 3. Walker et al. discloses wherein said readable storage device database further includes a rewards data file for storing rewards value ('653; Col. 14, lines 24-41).

Claim 15 is rejected as the same reason with Claim 4.

9. With respect to Claim 6, the combined art teaches a system according to claim 5. Walker et al. discloses wherein at least one of said first and second supplier systems provides value to said rewards data file ('653; Col 15, lines 37-50).

Claim 16 is rejected as the same reason with Claim 6.

10. With respect to Claims 7 and 8, the combined art teaches a system according to claim 6. Walker et al. discloses wherein said value is provided in accordance with said user data, and wherein said value is provided in response to receipt of said user data ('653; Col. 16, lines 10-43).

Claim 17 is rejected as the same reason with Claims 7 and 8.

11. With respect to Claim 9, the combined art teaches a system according to claim 3. Walker et al. discloses wherein said readable storage device stores said first membership indicia prior to storing said second membership indicia ('653; Fig 4).

Claim 18 is rejected as the same reason with Claim 9.

12. With respect to Claim 10, the combined art teaches a system according to claim 3. Walker et al. discloses wherein said readable storage device stores said first and second membership indicia substantially simultaneously ('653; Fig. 4).

Claim 19 is rejected as the same reason with Claim 10.

13. With respect to Claim 11, the combined art teaches a system according to claim 3. Walker et al. discloses wherein said readable storage device stores at least one of said first and second membership indicia automatically ('653; Col. 12, lines 26-55).

Claim 20 is rejected as the same reason with Claim 11.

14. Claim 21 is rejected as the same reason with Claim 1.

15. With respect to Claim 22, , the combined art teaches a method according to claim 21:

Walker et al. discloses further comprising:

receiving at least one of the unique membership numbers from the storage device upon presentation of the device to a first service provider, the unique membership number identifying the user as a member of a first service provider membership program and authenticating authenticity of at least the membership number and user ('653; Fig 4; Col. /line 13/49-14/8);

providing rewards points to the storage device in accordance with at least one of the unique membership number and a transaction indicia; and providing means for storing the rewards points for later redemption ('653; Col. 16, lines 10-43).

16. Claim 24 is rejected as the same reason with claim 21.

17. Claim 23 is rejected as the same reason with claim 12.

18. Claims 5, 25 are rejected under 35 U.S.C.103(a) as being unpatentable over Erickson (US. 6,014,644) in view of Walker et al. (US. 5,945,653), and further Zalewski et al. (US 6,771,981.)

19. With respect to Claim 5, the combined art teaches a system according to claim 4. Walker et al. discloses further including a first supplier reader and a second supplier reader, said first and second supplier readers in communication with said enrollment system, said first and second supplier readers for providing said interrogation signal and receiving at least one of said first and second membership indicia ('981; Col. /line 10/39-11/3).

20. With respect to Claim 25, the combined art teaches a method according to 24. Zalewski et al. discloses wherein the transfer of at least one of said rewards points, user specific data, and unique membership number is via RF ('981; Col. 12, lines 1-8).

Response to Amendment/Arguments

21. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571) 270-5211. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/H. N./
Examiner, Art Unit 3686
April 8, 2010

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686